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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,482	08/31/2001	Carl Brock Brandenburg	0590MH-40404-A	2351

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EXAMINER

NGUYEN, NHON D

ART UNIT PAPER NUMBER

2179

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,482

Applicant(s)

BRANDENBERG ET AL.

Examiner

Nhon (Gary) D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This communication is responsive to amendment, filed 03/10/2005.
2. Claims 1-5 are pending in this application. Claim 1 is independent claim. In this amendment, no claim is canceled, claim is amended, and claims 2-5 are added. This action is made final.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Gershman et al. ("Gershman", US 6,199,099).

As per independent claim 1, Gershman teaches a method of presenting digital content to a user on a computing device, the method comprising the steps of:

providing a display on the computing device (138 of fig. 1), wherein the display includes a portion thereof defining a stream portion (e.g. 2370 and 2395 of fig. 23);

displaying a continuous stream of digital content items in the stream portion of the display (1001 of fig. 10B; col. 31, lines 37-40 and col. 34, lines 22-23; e.g. 2370 and 2395 of fig. 23);

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obtaining a current context of the user and the computing device (col. 31, lines 40-44 and col. 34, lines 22-23);

providing contextual sensitivities for the digital content items (col. 31, lines 40-55 and col. 34, lines 15-20);

determining a value for each digital content item's relevance of being displayed; calculating a probability of displaying each digital content item based upon the value of such digital content item's relevance of being displayed; performing a selection of digital content items based upon the probability of displaying the digital content items (col. 34, lines 21-40); and

presenting the selected digital content items in the stream of digital content being displayed (col. 34, lines 40-42);

it is inherent in Gershman's system that the stream portion of the display area may be selectively turned on and off by the user (by opening and closing the application window).

As per claim 2, Gershman teaches the step of performing a selection of digital content items comprise performing a random selection of digital content items (col. 34, lines 21-40).

As per claim 3, Gershman teaches the contextual sensitivities comprise whether the device is connected to a network (fig. 1; col. 4, lines 18-44).

As per claim 4, Gershman teaches the stream portion of the display, when not turned off by the user, overlaps a portion of other data information items being presented on the display

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(e.g. pop-up windows 2370 and 2395 of fig. 23 may overlap a portion of other data information items in the background).

As per claim 5, it is inherent in Gershman's system that the user can adjust the size and location of the pop-up windows 2370 and 2396 (stream portion), for example, on the display.

Response to Arguments

5. Applicant's arguments filed 03/10/2005 have been fully considered but they are not persuasive.

Applicant argued the following:

Referring to claim 1, as set forth in the description, context relates to the specifics of the operating environment, rather than user preferences. Context is described in the specification at page 43, line 2 – page 60, line 24. Examples of context include location, network connectivity status, whether or not the device is being operated on a battery, and whether the display is turned on. These issues are not mentioned or considered in the Gershman reference, nor any of the other references of record. Further, nothing in Gershman obviates the rating of streaming elements based on environmental factors, and the determination of which streaming elements to display based on the results of such determination.

Examiner disagrees for the following reasons:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *context relates*

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to the specifics of the operating environment, rather than user preferences. Context is described in the specification at page 43, line 2 – page 60, line 24. *Examples of context include location, network connectivity status, whether or not the device is being operated on a battery, and whether the display is turned on*, and the rating of streaming elements *based on environmental factors*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, claim 1 remains rejected.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Inquiries

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon (Gary) D Nguyen whose telephone number is (571)272-4139. The examiner can normally be reached on Monday - Friday with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571)272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nhon (Gary) Nguyen
April 22, 2005

BA HUYNH
PRIMARY EXAMINER